

## **REMARKS**

The Office Action dated November 5, 2004 has been read and carefully considered and the present amendment is submitted to place this application in condition for allowance.

### **I. 35 U.S.C. § 112 Rejections**

In the above-identified Office Action, Claims 51 and 64 were rejected under 35 U.S.C. § 112, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 51 and 64 have been amended in a manner which is believed to overcome this rejection. Specifically, the amended claims now recite the occurrence of a successful check and an unsuccessful check as alternative outputs of instruction (c) or step (d) in claims 51 and 64, respectively. Accordingly, withdrawal of this rejection is respectfully requested.

### **II. Double Patenting**

Terminal Disclaimer is being submitted to overcome the obviousness-type double patenting rejection.

### **III. Information Disclosure Statement**

An Information Disclosure Statement ("IDS") and the required statement under 37 CFR 1.97(d) are also being submitted with this Amendment. This IDS is being filed to bring certain information, filed by the accused infringer in litigation alleging its infringement of U.S. Patent No. 6,463,416 ("the '416 Patent), to the attention of the Examiner. The '416 Patent is the parent of the presently pending continuation application.

The '416 Patent, along with U.S. Patent No. 6,523,741 ("the '741 Patent")<sup>1</sup>, are the subject of a pending patent infringement suit filed by Intelli-Check, Inc. ("Intelli-Check"), the assignee of both the '416 and '741 Patents against Tricom Card Technologies, Inc. ("Tricom") in the U.S. District, Eastern District of New York. In this litigation, Tricom has alleged that both the '416 Patent and '741 Patents are invalid and, to support these allegations, initially submitted the Expert Report of Ray Streckenrider, dated September 8, 2004 ("the Streckenrider Report"). In response, Intelli-Check submitted the Rebuttal Report of Victor Zazzu to Expert Witness Report of Ray Streckenrider, dated October 6, 2004, ("the Zazzu Report"). Tricom then submitted the Expert Rebuttal Report of Ray Streckenrider, dated October 18, 2004 ("the Streckenrider Rebuttal Report"). The Streckenrider Report, the Zazzu Report, and the Streckenrider Rebuttal Report are listed in the IDS and copies of these documents are being provided herewith.

The Streckenrider Report on page 4, first paragraph, states that the opinions expressed are based on two different pieces of prior art, namely, the published ID-Check source code (Tab 4 of the submitted Streckenrider Report) and the AAMVA Best Practices Recommendations for the Use of Magnetic Stripes (Tab 5 of the Streckenrider Report). These two different pieces of prior art have been cited to the USPTO during the prosecution of the '416 Patent as well as the present continuation application. In regard to the latter, the Examiner's attention is directed to the applicant's IDS dated March 20, 2002 and, in particular, the "Other Documents" referenced on Form PTO 1449 as "AS" and "AT". Moreover, in the Office Action of February 2, 2004, the Examiner apparently considered each of these references on January 25, 2004, as indicated by

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<sup>1</sup> The '416 Patent and the '741 Patent, while both assigned to Intelli-Check, have different lineage, i.e., different disclosures, different inventors, etc. The '741 Patent is a continuation-in-part application of a parent application filed on September 5, 1997, a date after the July 15, 1996 filing priority date of the '741 Patent and the present continuation application.

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his initialing and signature. Nevertheless, applicant is submitting all of the referenced expert reports to the Examiner for his review and consideration.

**IV. Correspondence**

Please address all correspondence to Intellectual Property Docket Administrator, Gibbons, Del Deo, Dolan, Griffinger & Vecchione, One Riverfront Plaza, Newark, NJ 07102-5496. Telephone calls should be made to David R. Padnes at (973) 596-4671 and fax communications should be sent directly to him at (973) 639-8335.

If any additional fees are due in respect to this amendment, please also charge them to Deposit Account No. 03-3839.

Respectfully submitted,

Date 12/2/04



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